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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/976,238

10/12/2001

David A. Basiji

BIOL0029

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06/02/2005

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EXAMINER

TRAN, MY CHAU T

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/976,238

Applicant(s)

BASIJ ET AL.

Examiner

MY-CHAU T. TRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,8-12 and 41-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,8-12 and 41-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Application and Claims Status***

1. Applicant's amendment and response filed 03/14/2005 is acknowledged and entered. Claims 1, 8, 49, and 50 have been amended.
2. Claims 1, 2, and 8 were amended and Claims 49-52 were added by the amendment filed on 02/09/2004.
3. Claims 3-7, and 13-40 were canceled; Claims 1 and 8 were amended; and Claims 41-48 were added by the amendment filed on 7/11/2003.
4. Claims 1-2, 8-12, and 41-52 are pending.
5. Claims 1, 2, 8-12, and 41-52 are treated on the merit in this Office Action.

### ***Priority***

6. It is noted that this instant application claims benefit to two provisional applications under 35 U.S.C 119(e). They are 60/242,734, filed 10/23/2000, and 60/240,125 filed 10/12/2000. Thus, the instant application is granted the benefit of priority for both provisional applications, which are 60/242,734, filed 10/23/2000, and 60/240,125 filed 10/12/2000.

***Maintained Objection(s) and/or Rejection(s)***

7. Claims 1, 2, 8-12, and 41-52 are treated on the merit in this Office Action.

***Claim Objections***

8. Claim 49 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 102***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. Claims 1-2, 8-12, and 41-49 are rejected under 35 U.S.C. 102(b) as being anticipated by The University of Queensland (WO 99/24458).

WO 99/24458 teaches the method of using an assembly of carrier having one or more reporter beads that are non-covalently attached in a combinatorial split-process-recombine procedure (see e.g. Abstract; pg. 1, lines 4-7; pg. 6, lines 21-24; pg. 7, lines 2-4; figs. 6-8). The method comprises the steps of 1) the carriers are split into two portions in reaction vessels; 2) one portion is mixed with the red reporter beads and the other portion is mixed with the green reporter beads (refers to claims 1-2, 8-9, and 49); 3) the carrier is wash to remove excess reporter

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beads; 4) different monomers are added to each portion mixture; 5) the portion mixtures are recombine and split into two portions; and steps 2-5 are repeated until a library of molecules is formed wherein each molecules will have a unique signal associated with it (see pg. 7, line 13 to pg. 8, line 7; pg. 32, line 12 to pg. 34, line 10; figs. 6-8). The reporter beads have properties such as color, fluorescence signal, and detectable physical feature such as size wherein the sequence of the synthesis applied to any carrier is determine from the reporter bead attached to the carrier (refers to claims 10-11, 41-48) (see pg. 24, lines 7-20; figs. 6-8). Therefore, the method of WO 99/24458 anticipates the presently claimed method.

11. Claims 1-2, 8-12, and 41-52 rejected under 35 U.S.C. 102(e) as being anticipated by Seul et al. (US Patent Application Publication 2002/0090613 A1; *filing date 11/22/1999*).

Seul et al. teaches a method for the physio-chemical encoding (refers to reporters) of a collection of beaded resin to determine the chemical identity of bead-anchored compounds (see e.g. Abstract; paragraphs: [002], [0026], and [0085]-[0102]). The encoding of the beads is a set of fluorophores that provide binary and extended binary codes (refers to claims 11, 43-44, 47-48, and 52) (see e.g. paragraphs: [0027], and [0042]-[0054]) and the color codes is further augmented by varying the parameters of the beads such as shape, and size (refers to claims 10, 12, 41-42, and 45-46) (see e.g. paragraphs: [0029], and [0056]). The method comprises the steps of providing plurality reaction vessels wherein each reaction vessel contains plurality of beads, adding to each vessel a different fluorophores that would result in different color encoded beads for each reaction vessels (refers to claims 1-2, 8-9, 49, and 50-51) (see e.g. paragraphs: [0085]-

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[0102], and [0106]-[0107])). Thus the method of Seul et al. anticipates the presently claimed method.

12. Claims 1-2, 8-9, 11, 43-44, and 47-49 are rejected under 35 U.S.C. 102(e) as being anticipated by The University of Queensland (WO 00/32542; *filing date 11/30/1998*).

WO 00/32542 teaches a method of producing plurality of carriers that are pre-encoded with information sufficient to distinguish it from a heterogeneous population of carriers (see e.g. Abstract; pg. 1, lines 3-7; pg. 7, lines 11-23; pg. 19, lines 1-9; pg. 27, lines 7-17; pg. 43, lines 1-11). The method comprises the steps of providing separate batches of seed microspheres with different concentration of fluorophores for each batch, repooling and randomly splitting into new batches, and adding different concentrations of new fluorophore to each batch (refers to claims 1-2, 8-9, and 49) (see e.g. pg. 7, lines 11-23; pg. 19, lines 1-9; pg. 27, lines 7-17; pg. 43, lines 1-11). Thus the method of WO 00/32542 anticipates the presently claimed method.

***Withdrawn Rejection(s)***

13. The rejections of claims 1, 2, 8-12, and 41-52 under 35 USC 112, first paragraph (new matter) have been withdrawn in light of applicant's arguments, see pages 9-16, filed 03/14/2005.

14. The rejections of claims 1, 2, 8-12, and 41-52 under 35 USC 112, second paragraph, as being indefinite has been withdrawn in light of applicant's amendments of claims 1, 8, 49, and 50.

***Response to Arguments***

15. Applicant's argument directed to the objection of claim 49 as being a substantial duplicate of claim 1 has been fully considered but they are not persuasive. Applicant's arguments are not convincing since the limitation following the term "consisting" of claim 49 (subparagraph (f)) is similar to the limitation found in subparagraph (f) of claim 1, i.e. a library of carriers with optically distinct reporters. Additionally, there is no term "comprising" found in subparagraph (f) of claim 1. Thus, the objection is maintained.

16. Applicant's arguments directed to the rejection under 35 USC 102(b) as being anticipated by The University of Queensland (WO 99/24458) for claims 1-2, 8-12, and 41-49 were considered but they are not persuasive for the following reasons.

Applicant contends that the method of WO 99/24458 does not anticipate the presently claimed method because 1) WO 99/24458 does not disclose "*a plurality of carriers to which have been attached unique combinations of reporters, but no compounds of interest (such as amino acid sequences)*"; 2) WO 99/24458 "*does not teach or suggest carriers that are themselves optically distinct from each other*" of claim 2; and 3) WO 99/24458 does not teach or suggest any utility for the reporter labeled carrier. Therefore, the method of WO 99/24458 does not anticipate the presently claimed method.

Applicant's arguments are not convincing since the method of WO 99/24458 does anticipate the presently claimed method.

First, the presently claimed method does not exclude the additional method step of WO 99/24458 wherein a compound is attached to the reporter labeled carrier. That is the phrase

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*“comprising the steps of”* and/or the limitation that *“such that compounds of interest can later be attached to the optically distinct reporter labeled carriers of the blank library”* of claims 1, 8 and 49 do not exclude the additional step of attaching a compound to the reporter labeled carrier as disclosed by WO 99/24458. Thus, the method of WO 99/24458 does teach or suggest, *“a plurality of carriers to which have been attached unique combinations of reporters”*.

Second, WO 99/24458 does disclose carriers that are optically distinct from each other as claimed in claim 2 (pg. 32, lines 14-20; figs. 6-8). Thus, WO 99/24458 does disclose carriers that are optically distinct from each other as claimed in claim 2.

Third, in response to applicant's argument that WO 99/24458 does not teach or suggest any utility for the reporter labeled carrier, the examiner recognize that in order to constitute anticipatory prior art, a reference must identically disclose the claimed compound, but no utility need be disclosed by the reference...See, for example, *In re Schoenwald*, 964 F.2d 1122, 22 USPQ2d 1671 (Fed. Cir. 1992). Here, WO 99/24458 does identically disclose the claimed compound, i.e. reporter labeled carrier, and a utility for the reporter labeled carrier, i.e. attachment of compound, is similar that of the presently claimed method. This utility is claimed by the presently claimed method, i.e. claims 1 and 8, and is disclose by the specification of the instant application, i.e. pg. 12, line 6 thru pg. 13, line 5; fig. 9.

Thus, the method of WO 99/24458 does anticipate the presently claimed method, and the rejection is maintained.

17. Applicant's arguments directed to the rejection under 35 USC 102(e) as being anticipated by Seul et al. (US Patent Application Publication 2002/0090613 A1; *filing date 11/22/1999*) for



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claims 1-2, 8-12, and 41-52 were considered but they are not persuasive for the following reasons.

Applicant alleges that the method of Seul et al. does not anticipate the presently claimed method because 1) Seul et al. does not teach or suggest a plurality of reporter labeled carrier with no compound attached, and 2) Seul et al. does not teach or suggest carriers that are optically distinct from each other as claimed in claim 2. Therefore, the method of Seul et al. does not anticipate the presently claimed method.

Applicant's arguments are not convincing since the method of Seul et al. does anticipate the presently claimed method.

First, the presently claimed method does not exclude the additional method step of WO 99/24458 wherein a compound is attached to the reporter labeled carrier. That is the phrase ***"comprising the steps of"*** and/or the limitation that ***"such that compounds of interest can later be attached to the optically distinct reporter labeled carriers of the blank library"*** of claims 1, 8 and 49 do not exclude the additional step of attaching a compound to the reporter labeled carrier as disclosed by Seul et al. Thus, the method of WO 99/24458 does teach or suggest a plurality of reporter labeled carrier with no compound attached.

Second, Seul et al. does disclose carriers that are optically distinct from each other as claimed in claim 2 (paragraphs: [0085]-[0102]). Thus, Seul et al. does disclose carriers that are optically distinct from each other as claimed in claim 2.

Thus, the method of Seul et al. does anticipate the presently claimed method, and the rejection is maintained.

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18. Applicant's arguments directed to the rejection under 35 USC 102(e) as being anticipated by The University of Queensland (WO 00/32542; *filing date 11/30/1998*) for claims 1-2, 8-9, 11, 43-44, and 47-49 were considered but they are not persuasive for the following reasons.

Applicant argues that the method of WO 00/32542 does not anticipate the presently claimed method because 1) WO 00/32542 does not teach or suggest the presently claimed method, and 2) WO 00/32542 does not does not teach or suggest carriers that are optically distinct from each other as claimed in claim 2. Therefore, the method of WO 00/32542 does not anticipate the presently claimed method.

Applicant's arguments are not convincing since the method of WO 00/32542 does anticipate the presently claimed method.

First, WO 00/32542 does disclose the presently claimed method (pg. 44; pg. 46, lines 10 thru pg. 49, line 13). Second, WO 00/32542 does disclose carriers that are optically distinct from each other as claimed in claim 2 (pg. 45, Table C). Thus, the method of WO 00/32542 does anticipate the presently claimed method, and the rejection is maintained.

### ***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct  
May 31, 2005

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER